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BRIEF FOR APPELLANT, JEAN MARIE CLEMENT

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U.S. PATENT & TRADEMARK OFFICE

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

97-1202
(Serial No. 08/054,951)

IN RE CLEMENT

APPEAL FROM A DECISION OF THE BOARD OF PATENT
APPEALS AND INTERFERENCES DATED JUNE 26, 1996

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Date: March 21, 1997

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

IN RE CLEMENT

Appeal No. 97-1202

Certificate of Interest

Counsel for the Appellant, Jean-Marie Clément, certifies the following:

1. The full name of the party represented by me is Jean Marie Clément.
2. The name of the real party in interest represented by me is Jean Marie Clément.
3. There are no parent companies, subsidiaries or affiliates that have issued shares to the public, of the party represented by me.
4. The names of all law firms and the partners or associates that appeared for the party now represented by me in the Patent and Trademark Office proceedings below are Wolf, Greenfield & Sacks, P.C. and McCormick, Paulding & Huber.



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STATEMENT OF RELATED CASES

The reissue patent of this appeal is based upon United States Patent No. 4,780,179 (the '179 patent). The '179 patent was the subject of litigation in the United States District Court for the District of Columbia, Kamyr, Inc. v. Clement, Civil Action No. 94-2234 (JR). Summary Judgment of non-infringement was entered in favor of Kamyr on January 31, 1997. A Notice of Appeal to this Court was filed on February 27, 1997. The case has not yet been docketed.

**STATEMENT OF SUBJECT MATTER AND
APPELLATE JURISDICTION**

1. This appeal seeks review of a final decision dated June 26, 1996, of the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office, rejecting claims 1-18 and 49-52 of reissue application serial no. 08/054,951. Jurisdiction in the Board of Patent Appeals and Interferences was based on 35 U.S.C. § 134.

2. Subject matter and appellate jurisdiction for this Court lie under 28 U.S.C. § 1295(a)(4)(B) and 35 U.S.C. § 141.

3. A notice of appeal was filed on November 6, 1996. An extension of time under 37 C.F.R. § 1.304(a)(3)(ii) to and including November 6, 1996, was granted by the Commissioner to file the notice of appeal.

STATEMENT OF ISSUES

1. Whether the Board of Patent Appeals and Interferences (the Board) erred in rejecting claims 49-52 in Clement's reissue application as being barred by the recapture rule.
2. Whether the Board erred in rejecting claims 49-52 as being based on a defective reissue declaration under 35 U.S.C. § 251 and 37 C.F.R. § 1.175.
3. Whether the Board erred in rejecting claims 1-18, which are identical to claims 1-18 as issued in the original patent, as being barred by the recapture rule and as being based on a defective reissue declaration.

STATEMENT OF THE CASE

1. *Nature of the Case, The Course of the Proceedings and Its Disposition Below*

This is an appeal from a final decision of the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office (the Board) affirming the Examiner's final rejection of all claims (i.e., claims 1-18 and 49-52) pending in Clement's reissue patent application.

The present reissue application, serial no. 08/054,951, was filed on April 27, 1993. This application is a continuation of application serial no. 07/600,012, now abandoned, filed on October 18, 1990. Both applications sought reissue of U.S. Patent No. 4,780,179 (the '179 patent). The '179 patent issued October 25, 1988 from application serial no. 06/822,943, filed January 27, 1986, which was a continuation of application no. 06/482,623, filed April 6, 1983, now abandoned.

The claims in the present reissue application were finally rejected by the Examiner on three grounds: (1) Claims 49-52 were rejected under 35 U.S.C. § 251 as being broadened in a reissue application filed outside the two year statutory period; (2) Claims 1-18 and 49-52 were rejected under 35 U.S.C. § 251 and 37 C.F.R. § 1.175 as being based upon a defective reissue declaration; and (3) Claims 1-18 and 49-52 were rejected under 35 U.S.C. § 251 as lacking a basis for reissue, since recapture is not an error correctable by reissue. The Board reversed the Examiner on the first ground of rejection, and affirmed the Examiner's rejection of claims 1-18 and 49-52 on the second and third grounds.

2. *Statement of the Facts Relevant To The Issues Presented For Review*

Appellant, Jean-Marie Clement (Clement) is a French citizen residing in Italy. (A43; Clement Reissue Declaration filed April 24, 1993 at 8.) Clement is the sole named inventor and sole owner of the '179 patent.

The '179 patent issued from application serial no. 06/822,943 filed January 27, 1986 (continuation application), which was a continuation of application serial no. 06/482,623, filed April 6, 1983 (parent application). The '179 patent relates to a process for producing pulp by recycling waste paper. The process is designed to remove thermosensitive contaminants from the pulp which have low melting points, such as binders, hot melts, plastics and other like "stickies." After removing the "stickies," inks that are bound to the paper's surface are removed from the pulp. To remove the inks, the pulp must be subjected to temperatures, mechanical energy, and chemicals that would otherwise disperse the "stickies" throughout the pulp, and create the aforementioned disadvantages. Thus, the process removes substantially all of the "stickies" before the ink removal steps occur, to prevent substantial dispersal of the "stickies" throughout the pulp.

Claim 1 as originally filed in the parent application is set forth below:

1. A method of treating a mixture of printed and contaminated waste paper in order to produce pulps for the use in the manufacture of pulp and paper boards, which method comprises:
 - (a) forming an aqueous pulp of said waste material at low temperature, low specific mechanical energy, thereby forming a pulpable slurry and releasing the non-ink contaminants from the surface of the paper but without dispersing them inside the fibrous suspension;
 - (b) separating the non-ink contaminants from the pulp by mechanical separation, without the use of froth flotation or solvent extraction or other process, using conventional screens and centrifugal cleaners and without any further application of strong shear forces to the pulp;

- (c) softening of the ink particles vehicles and weakening of their bondings with the surface of the fibres by submitting the pulp at a consistency of more than 15% at the simultaneous actions of (A) high temperature - between 85 and 130°C. - (B) high shear forces and (C) at least one de-inking agent, under alkaline conditions;
- (d) detaching the ink particles from the surface of the fibres and dispersing them into the fibrous suspension by submitting the pulp to the simultaneous actions of (A) high temperature -between 85 and 130°C. - (B) high shear forces and (C) at least one chemical dispersing agent, under alkaline conditions;
- (e) removing the free ink particles by means of the most appropriate known method and up to the degree of brightness required by the final use of the pulp.

(A231.) A first office action dated May 30, 1984, contained a restriction requirement, and an objection to language the Examiner found indefinite. (A240-41.) In an amendment dated July 2, 1984, claim 1 was amended to remove the objectionable language:

1. (Amended) A method of treating a mixture of printed and contaminated waste paper in order to produce pulps for the use in the manufacture of pulp and paper boards, which method comprises:
 - (a) forming an aqueous pulp of said waste material at low temperature, low specific mechanical energy, thereby forming a pulpable slurry and releasing the non-ink contaminants from the surface of the paper but without dispersing them inside the fibrous suspension;
 - (b) separating the non-ink contaminants from the pulp by mechanical separation, without the use of froth flotation or solvent extraction or other process, using conventional screens and centrifugal cleaners and without any further application of strong shear forces to the pulp;
 - (c) softening of the ink particles vehicles and weakening of their bondings with the surface of the fibres by submitting the pulp at a consistency of more than 15% at the simultaneous actions of (A) high temperature - between 85 and 130°C. - (B) high shear forces and (C) at least one de-inking agent, under alkaline conditions;
 - (d) detaching the ink particles from the surface of the fibres and dispersing them into the fibrous suspension by submitting the pulp to the simultaneous actions of (A) high temperature -between 85 and 130°C. -

(B) high shear forces and (C) at least one chemical dispersing agent, under alkaline conditions;

- (e) removing the free ink particles [by means of the most appropriate known method and up] to provide the degree of brightness required by the final use of the pulp.

(A246-47.) In an office action dated April 9, 1985, claim 1 was rejected under 35 U.S.C. § 103 as being unpatentable over Ortner et al. in view of Raymond et al. and Ericksson.

(A254.) Claim 1 also was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because of the use of the terms "low" and "high" in the claim. (A255.) The Examiner stated that these claim terms "are too relative tube [sic] capable of any fixed meaning." (A255.) In response to this rejection, Clement's U.S. counsel amended claim 1 in a amendment filed on July 9, 1985:

1. (Twice Amended) A method of treating a mixture of printed and contaminated waste paper in order to produce pulps for the use in the manufacture of [pulp] paper and paperboards, which method comprises:

- (a) forming an aqueous [pulp] fibrous suspension of said waste material at [low] room temperature, applying [low] specific mechanical energy generally lower than 50 KW.H/Ton [, thereby forming] to form a [pulpable] pumpable slurry [and releasing the non-ink contaminants from the surface of the paper but without dispensing them inside] in which only the ink is dispersed as fine particles in the fibrous suspension;
- (b) separating the non-ink contaminants from the [pulp] fibrous suspension by mechanical [separation] means, without the use of froth flotation or solvent extraction of [other] like process, using [conventional] screens and centrifugal cleaners [and without any further application of strong substantial shear forces to the pulp];
- (c) softening the ink [particles] vehicles and weakening [of] their [bondings] binding with the surface of the fibres by submitting the [pulp] fibrous suspension at a consistency of more than 15% at the simultaneous actions of (A) high temperature - between 85 and 130°C - (B) high shear forces substantially corresponding to a specific mechanical energy of more than 50 KW.H/Ton during less than 10 minutes applied at the said consistency of more than 15% and (C) at least one de-inking agent, alkaline conditions;

- (d) detaching the ink particles from the surface of the fibres and dispersing them into the fibrous suspension by submitting the [pulp] fibrous suspension to the simultaneous actions of (A) high temperature - between 85 and 130°C - (B) high shear forces substantially corresponding to a specific mechanical energy of more than 50 KW.H/Ton during less than 10 minutes applied at the said consistency of more than 15% and (C) at least one chemical dispersing agent, under alkaline conditions; the total duration of the ink releasing and dispersing treatment (c) and (d) being kept between 2 and 10 minutes;
- (e) removing the free ink particles [to provide the degree of brightness required by the final use of the pulp] which have been detached from the fibres.

(A257-60.) On August 28, 1985 the Examiner finally rejected claim 1 under 35 U.S.C. § 103 as being unpatentable over Ortner et al. in view of Raymond et al. and Ericksson.

(A268-71.)

On January 27, 1986, the continuation application was filed. A preliminary amendment accompanied the continuation application in which claim 1 was canceled and replaced with new claim 42, which constituted old claim 1 rewritten to include substantially all of the amendments made to claim 1 during the prosecution of the parent application, as to make well as other minor changes:

42. A method of treating a mixture of printed and contaminated waste paper in order to produce pulps for use in the manufacture of paper and paperboards, which method comprises:

- (a) forming an aqueous fibrous suspension of said waste paper at room temperature without de-inking agents by applying specific mechanical energy lower than 50 KW.H/Ton to form a pumpable slurry and to release the contaminants from the surface of the paper fibers in the absence of de-inking agents and without dispersing such contaminants as finely divided particles throughout the fibrous suspension;
- (b) removing the released contaminants from the fibrous suspension by mechanical means;
- (c) softening the ink vehicles and weakening their binding with the surface of the fibers by submitting the fibrous suspension at a consistency of more than 15% to the simultaneous actions of (A) a high temperature

between 85° and 130°C. (B) high shear forces substantially corresponding to a specific mechanical energy of more than 50 KW.H/Ton applied at the said consistency of more than 15% and (C) at least one de-inking agent under alkaline conditions;

- (d) detaching the ink particles from the surface of the fibers and dispersing them into the fibrous suspension by submitting the fibrous suspension to the simultaneous actions of (A) high temperature between 85° and 130°C. (B) high shear forces substantially corresponding to a specific mechanical energy of more than 50 KW.H/Ton applied at the said consistency of more than 15% and (C) at least one chemical dispersing agent, under alkaline conditions;
- (e) limiting the total duration of the ink softening and detaching steps (c) and (d) to a range between 2 and 10 minutes; and
- (f) removing the detached ink particles to provide the degree of brightness required in the final product of the pulp from the fibrous suspension.

(A325-26.) On September 23, 1986, in a first office action, claim 42 was rejected under 35 U.S.C. § 103 as being unpatentable over the Burns article, alone or in view of Ericksson. (A338-39.) With respect to this new rejection, the Examiner stated that "the Burns system is clearly closer prior art than the Ortner et al. patent." (A341.)

Clement's U.S. counsel filed an amendment on December 23, 1986, in which Claim 42 was amended as follows:

42. (Amended) A method of treating a mixture of printed and contaminated waste paper in order to produce pulps for use in the manufacture of paper and paperboards, which method comprises:

- (a) forming an aqueous fibrous suspension of said waste paper at room temperature without de-inking agents by applying specific mechanical energy lower than 50 KW.H/Ton to form a pumpable slurry and to release the non-ink contaminants from the surface of the paper fibers in the absence of de-inking agents and without dispersing such non-ink contaminants as finely divided particles throughout the fibrous suspension;
- (b) removing the released non-ink contaminants from the fibrous suspension by [mechanical means] screening and cleaning;

- (c) softening the ink vehicles and weakening their binding with the surface of the fibers by submitting the fibrous suspension at a consistency of more than 15% to the simultaneous actions of (A) a high temperature between 85° and 130°C. (B) high shear forces substantially corresponding to a specific mechanical energy of more than 50 KW.H/Ton applied at the said consistency of more than 15% and (C) at least one de-inking agent under strong alkaline (sic) conditions having a pH preferably greater than 9;
- (d) detaching the ink particles from the surface of the fibers and dispersing them into the fibrous suspension by submitting the fibrous suspension to the simultaneous actions of (A) high temperature between 85° and 130°C. (B) high shear forces substantially corresponding to a specific mechanical energy of more than 50 KW.H/Ton applied at the said consistency of more than 15% and (C) at least one chemical dispersing agent, under strong alkaline conditions having a pH preferably greater than 9;
- (e) limiting the total duration of the ink softening and detaching steps (c) and (d) to a range between 2 and 10 minutes; and
- (f) removing the detached ink particles to provide the degree of brightness required in the final product of the pulp from the fibrous suspension.

(A345-46.)

On April 8, 1987, the Examiner issued a final rejection on the same grounds as the September 22, 1986 rejection. (A360.) Claim 42 was again amended, after final, on June 29, 1987:

42. (Twice Amended) A method of treating a mixture of printed and contaminated waste paper in order to produce pulps for use in the manufacture of paper and paperboards, which method comprises:

- (a) forming a first aqueous fibrous suspension of said waste paper at room temperature [without de-inking agents] by applying specific mechanical energy lower than 50 KW.H/Ton to form a pumpable slurry and to release the non-ink contaminants from the surface of the paper fibers [in the absence of de-inking agents] and without dispersing such non-ink contaminants as finely divided particles throughout the fibrous suspension;
- (b) removing the [released] non-ink contaminants which have been released without dispersal as finely divided particles from the first fibrous

suspension by screening and cleaning to form a second aqueous fibrous suspension substantially free of non-ink contaminants;

- (c) after the step of removing the non-ink contaminants softening the ink vehicles and weakening their binding with the surface of the fibers by submitting the second fibrous suspension at a consistency of more than 15% to the simultaneous actions of (A) a high temperature between 85° and 130°C. (B) high shear forces substantially corresponding to a specific mechanical energy of more than 50 KW.H/Ton applied at the said consistency of more than 15% and (C) at least one de-inking agent under strong alkaline (sic) conditions having a pH [preferably greater than] of at least 9; and
- (d) detaching the ink particles from the surface of the fibers and dispersing them into the second fibrous suspension by submitting the second fibrous suspension to the simultaneous actions of (A) high temperature between 85° and 130°C. (B) high shear forces substantially corresponding to a specific mechanical energy of more than 50 KW.H/Ton applied at the said consistency of more than 15% and (C) at least one chemical dispersing agent, under strong alkaline conditions having a pH [preferably greater than] of at least 9 whereby higher specific energy inputs and higher temperatures are used to detach the ink particles from the fibers of the second fibrous suspension after removal of the non-ink contaminants than are used on the first fibrous suspension before removal of the non-ink contaminants;
- (e) limiting the total duration of the ink softening and detaching steps (c) and (d) to a range between 2 and 10 minutes; and
- (f) removing the detached ink particles to provide the degree of brightness required in the final product of the pulp.

(A378-80.) A Notice of Appeal was filed on July 31, 1987. (A388.) An appeal brief was filed on September 30, 1987. (A389.) The Examiner's Answer to the appeal brief was filed on December 9, 1987. (A411.) A reply brief in response to the Examiner's Answer was filed on March 7, 1988. (A419.) An interview was then held with the Examiner, (A426), in which the Examiner agreed to allow the claims provided the following amendment was made to claim 42:

42. A method of treating a mixture of printed and contaminated waste paper in order to produce [pulp] a pulp for use in the manufacture of paper and paperboards, said waste paper including non-ink contaminants including stickies which method comprises:

- (a) forming a first aqueous fibrous suspension of said waste paper at room temperature by applying specific mechanical energy lower than 50 KW.H/Ton to form a pumpable slurry and to release substantially all of the non-ink contaminants, including the stickies, from the surface of the paper [fibers] and without dispersing such non-ink contaminants as finely divided particles throughout the fibrous suspension;
- (b) removing substantially all of the non-ink contaminants, including the stickies, which have been released without dispersal as finely divided particles from the first fibrous suspension by screening and cleaning at room temperature to form a second aqueous fibrous suspension substantially free of the non-ink contaminants[;] including the stickies;
- (c) after the step of removing the non-ink contaminants softening the ink vehicles and weakening their binding with the surface of the fibers by submitting the second fibrous suspension at a consistency of more than 15% to the simultaneous actions of (A) a high temperature between 85° and 130°C. (B) high shear forces substantially corresponding to a specific mechanical energy of more than 50 KW.H/Ton applied at the said consistency of more than 15% and (C) at least one de-inking agent under strong alkaline (sic) conditions having a pH of at least 9; and
- (d) detaching the ink particles from the surface of the fibers and dispersing them into the second fibrous suspension by submitting the second fibrous suspension to the simultaneous actions of (A) high temperature between 85° and 130°C. (B) high shear forces substantially corresponding to a specific mechanical energy of more than 50 KW.H/Ton applied at the said consistency of more than 15% and (C) at least one chemical dispersing agent, under strong alkaline conditions having a pH of at least 9 whereby higher specific energy inputs and higher temperatures are used to detach the ink particles from the fibers of the second fibrous suspension after removal of the non-ink contaminants than are used on the first fibrous suspension before removal of the non-ink contaminants;
- (e) limiting the total duration of the ink softening and detaching steps (c) and (d) to a range between 2 and 10 minutes; and
- (f) removing the detached ink particles from the second fibrous suspension to provide a [the degree of] brightness [required] of at least 59 ISO in [the final product of] the final pulp.

(A428.) After entry of the foregoing examiner's amendment, the '179 patent issued with claim 42 above becoming claim 1, the only independent claim in the '179 patent.

Clement filed parent reissue application serial no. 07/600,012 on October 18, 1990, to correct an error in the '179 patent of claiming more or less than he had a right to claim. (A37; Clement Decl. at 2.) These defects in the '179 patent were due to communication problems that Clement had with his U.S. attorneys, and a failure of Clement and his U.S. attorneys to appreciate that particular limitations did not need to be specifically recited in the claims. (A41-42; Clement Decl. at 6-7.) Clement subsequently abandoned the parent reissue application and timely filed continuation application serial no. 08/054,951 on April 27, 1993, claiming the benefit of the parent reissue application under 35 U.S.C. § 120. New claims 49-52 and claims 1-18 of the '179 patent were finally rejected by the Examiner, as an attempt to recapture subject matter surrendered during the prosecution of the '179 patent, and as being based on a defective oath. (A55-63.) Claims 49-52 also were rejected as being broadened in a reissue application filed outside the two year term provided by 35 U.S.C. § 251. (A55-63.) An appeal to the Board followed. The Board affirmed the rejection under the recapture rule and the defective oath and reversed the two-year broadening rejection. (A3.)

SUMMARY OF THE ARGUMENT

I. Standard of Review

Whether the statutory requirements of 35 U.S.C. § 251 have been met is an issue of law which is reviewed de novo by this Court. Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 994, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993).

II. The Recapture Rule Does Not Bar Reissue Claims That Are Narrower in At Least One Significant Respect than Claims Cancelled or Amended During the Prosecution of the Original Patent

If reissue claims are narrower in at least one significant respect than claims cancelled or amended to overcome the prior art, and the reissue claims overcome the prior art, the reissue claims are of a different scope from the amended or cancelled claims and are not subject to the recapture rule. In re Richman, 409 F.2d 269, 276, 161 USPQ 359, 364 (CCPA 1969). The recapture rule only bars a patentee from obtaining claims through reissue if the scope of the reissue claims is the same as, or broader, than that of claims cancelled or amended during the prosecution of the patent because of prior art. Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

To properly determine whether recapture bars reissue claims 49-52, a comparison is necessary between the reissue claims, (A25-28), and the claims in the prosecution history that do not include the limitations identified by the Board. Whittaker Corp. v. UNR Industries, Inc., 911 F.2d 709, 713, 15 USPQ2d 1742, 1745 (Fed. Cir. 1990). The Board held that reissue claims not including the "room temperature" and specific mechanical energy limitations could not be obtained because of the recapture rule. (A9; Board Decision at 9.) Claim 1 of the parent application was amended on July

9, 1985, to include the limitations identified by the Board. (A257-260.) Comparing claim 1 prior to the July 9, 1985, amendment with reissue claim 49 reveals that reissue claim 49 is materially narrower in several respects, including limitations reciting that: (1) the total duration of steps (c) (1) and (c) (2) is in a range of between two and ten minutes, (2) the brightness of the final pulp is at least 59 ISO, (3) substantially all of the non-ink contaminants, including the stickies, are removed prior to removing the ink, and (4) the first aqueous fibrous suspension is formed at a temperature below the melting point of the non-ink contaminants. These limitations cannot be considered insignificant as they distinguish Clement's reissue claims over the prior art. Accordingly, reissue claim 49 is materially narrower than claim 1 prior to the July 9, 1985 amendment and the Board erred in finding reissue claim 49, and claims 50-52 which depend therefrom, barred by the recapture rule.

Reissue claim 49 is also materially narrower in at least two significant respects than claim 1, (or claim 42, as claim 1 was rewritten as claim 42 in the continuation application, (A325-26)), at every point during the prosecution of the '179 patent. Claims 1 and 42 prior to cancellation or amendment never included either the 59 ISO brightness limitation, or the limitation that substantially all of the non-ink contaminants, including the stickies, are removed prior to removing the ink. Both limitations were required by the Examiner to be added to claim 42 after appeal and before allowing the claim.

(A428.) Accordingly, reissue claim 49 is materially narrower in these respects than all claims prior to amendment or cancellation during the prosecution of the '179 patent, and the Board erred in finding reissue claim 49, and claims 50-52 which depend therefrom, barred by the recapture rule.

The Board erred by reaching its conclusion focusing on the necessity of particular limitations included in the claims of the '179 patent but not in the reissue claims, rather than comparing the scope of the reissue claim with the scope of the original claims prior to cancellation or amendment. Focusing on the necessity of particular claim limitations, as the Board did, was expressly disapproved of in Ball Corp., 729 F.2d at 1436-37, 221 USPQ at 294-95.

III. The Reissue Declaration Complies With Both 35 U.S.C. § 251 and 37 C.F.R. § 1.175

35 U.S.C. § 251 sets forth two requirements that a reissue declaration must satisfy: (1) it must state that the patent is defective, for example, because the patentee has claimed more or less than he is entitled to; and (2) the patentee must allege that the defect arose through error without deceptive intent. Hewlett-Packard Co. v. Bausch & Lomb, Inc., 882 F.2d 1556, 1564, 11 USPQ2d 1750, 1757 (Fed. Cir. 1989). Clement's Declaration filed April 24, 1993 explicitly meets both of these requirements. (A37, 42; Clement Decl. at 2, 7.) Since the Board did not find that the reissue declaration did not meet these two requirements, the Board erred in rejecting the claims under 35 U.S.C. § 251 as being based on a defective reissue declaration.

37 C.F.R. § 1.175(a)(5) requires that the reissue declaration contain a statement "[p]articularly specifying the errors relied upon, and how they arose or occurred." The errors were particularly specified by Clement in his declaration, including a discussion of the room temperature limitation, the specific mechanical energy limitations, the temperature limitations of steps (c) and (d), and the pH limitation. (A39; Clement Decl. at 4.) The declaration describes how these errors, i.e., the inclusions of these limitations

in the claims, arose, citing communication difficulties with counsel, and failure of counsel and Clement to appreciate that these exact limitations did not need to be specifically recited in the claims to distinguish over the prior art. (A41-42; Clement Decl. at 6-7.) These very reasons have been found to constitute error sufficient to satisfy both 35 U.S.C. § 251 and 37 C.F.R. § 1.175. Mentor Corp., 998 F.2d at 995, 27 USPQ2d at 1524; Ball Corp., 729 F.2d at 1433, 221 USPQ at 292; In re Wesseler, 367 F.2d 838, 842, 151 USPQ 339, 342 (CCPA 1966).

IV. The Board Erred in Rejecting Claims 1-18

Without discussion, the Board rejected claims 1-18, along with claims 49-52, based on a defective declaration and based on the recapture rule. (A3; Board Decision at 3.) Claims 1-18 are identical to claims 1-18 in the original '179 patent, and Clement did not seek to change their scope. This rejection was improper, under Hewlett-Packard, 882 F.2d at 1567, 11 USPQ2d at 1759, in which this Court held that a rejection of new reissue claims because of a lack of error warranting reissue only invalidated the new reissue claims, not the original claims carried over into the reissue application. Id. Accordingly, the rejection of claims 1-18 under 35 U.S.C. § 251 was improper and should be reversed.

ARGUMENT

I. The Recapture Rule Does Not Bar Clement from Obtaining Reissue Claims 49-53

- A. The Reissue Statute Permits a Broadening Reissue So Long as The Reissue Claim Is Narrower in Scope in at Least One Significant Respect than the Original Application Claims Prior to Amendment

The patent statute permits a patentee to correct errors in its patent through reissue:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

35 U.S.C. § 251, para. 1, (1988).

One type of error correctable through reissue is where the patentee claimed less than he was entitled to claim. For such an error, the statute provides a 2-year limit for filing an application for reissue:

No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years of the grant of the original patent.

35 U.S.C. § 251, para. 4.

The '179 patent was issued to Clement on October 25, 1988. (A16.) On October 18, 1990, within two years of the issue date of his patent, Clement sought to obtain broader claims through reissue. Claim 49, the only independent new reissue claim on appeal, (A25-28), is broader in scope in some respects than claim 1 of the '179 patent. The error sought to be corrected was that Clement claimed more or less than he had a

right to claim. (A37; Clement Reissue Declaration, filed April 24, 1993, at 2). The error arose through communication difficulties with Clement's U.S. attorneys. (A41-42.) Therefore, under 35 U.S.C. § 251, Clement was entitled to acquire broader claims, provided that the error arose "without any deceptive intention." 35 U.S.C. § 251, para. 1.

A further restraint also has been imposed on the right of a patentee to obtain a broader claim on reissue. The patentee is not permitted to "recapture," through reissue, claims of the same or broader scope than those cancelled or amended in the original application. Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

1. To Determine Whether the Recapture Rule Applies, a Comparison is Necessary Between the Scope of the Reissue Claim and the Scope of the Claim the Patentee is Allegedly Trying to Recapture

In Ball Corp., 729 F.2d at 1435-36, 221 USPQ at 293-95, this Court analyzed the recapture rule at length. The recapture rule is based on the premise that cancellation of a claim to overcome prior art may amount to an admission that the cancelled claim was not patentable. This type of implicit admission is not an "error" as defined in 35 U.S.C. § 251, and therefore cannot be cured by reissue. See generally, Id. To determine whether the recapture doctrine applies, the scope of the claim prior to cancellation must be compared to the scope of the reissue claim:

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the *same* or of *broader scope* than those claims that were cancelled from the original application. On the other hand, the patentee is free to acquire, through reissue, claims that are *narrower* in scope than the cancelled claims.

Ball Corp., 729 F.2d at 1436, 221 USPQ at 295; see also, Whittaker Corp. v. UNR

Industries Inc., 911 F.2d 709, 713, 15 USPQ2d 1742, 1745 (Fed. Cir. 1990) ("Since we

hold that the claims of the reissue patent are narrower in scope than the cancelled original claims of the application that resulted in the '882 patent, the '453 patent cannot be held invalid under the recapture rule"); In re Richman, 409 F.2d, 269, 274, 161 USPQ 359, 362 (CCPA 1969) ("The question raised is whether the appealed claims are of the same scope as the cancelled claims, not whether they lack some specific recitation absent from the cancelled claims but included in the patent claims.").

2. The Same Approach to the Recapture Rule Applies Both to Cancellation and Amendment of Claims During Prosecution of the Original Patent

The same approach to the recapture rule is applied whether claims are amended or cancelled during prosecution. To determine whether the recapture rule bars a reissue claim where an original claim only has been amended and not cancelled during prosecution, the scope of the amended claim prior to amendment is compared with the scope of the reissue claim:

While claim 20 was not technically canceled, the amendment of that claim by the inclusion of an additional limitation had exactly the same effect as if the claim as originally presented had been canceled and replaced by a new claim including that limitation. So far as the right to reissue the patent is concerned, therefore, the case is to be treated as if original claim 20 had been canceled and replaced by the claim on which the patent was granted.

In re Byers, 230 F.2d 451, 455, 109 USPQ 53, 55 (CCPA 1956); See also, Mentor Corp., 998 F.2d at 995, 27 USPQ2d at 1524. Thus, for recapture to bar a reissue claim based on an amendment during prosecution, the reissue claim must be of the same or broader scope than the amended claim prior to amendment. In re Byers, 230 F.2d at 456, 109 USPQ at 56.

3. Reissue Claims Avoid the Recapture Rule if the Reissue Claims are Narrower than the Cancelled or Amended Claims in at Least One Significant Respect

To be "narrower" and avoid the recapture rule, the reissue claim need only be narrower in at least one significant respect than the cancelled claim, or the amended claim prior to amendment. In re Richman, 409 F.2d at 276, 161 USPQ at 364 ("It is thus apparent that each of the appealed claims is more restrictive in at least one significant respect than the cancelled claims and that appellant is not seeking, through the presentation of claims 23-28, to recapture the same subject matter that he sought in cancelled claims 1-15."); Mentor Corp., 998 F.2d at 996, 27 USPQ2d at 1525 ("Reissue claims that are broader in certain respects and narrower in others may avoid the recapture rule."); Ball Corp., 729 F.2d at 1438, 221 USPQ at 296 ("[T]he reissue claims are sufficiently narrower than the cancelled claims to avoid the effect of the recapture rule."); Freeman v. Minnesota Mining and Mfg. Co., 693 F.Supp. 134, 155, 9 USPQ2d 1111, 1130 (D. De. 1988) ("[C]laims broader than the claims of the original patent are permissible only if they are more restrictive in at least one significant respect than the cancelled claims."), aff'd in part and vacated in part, 884 F.2d 1398, 12 USPQ2d 1250 (Fed. Cir. 1989). The implicit admission that a claim is unpatentable over the art because of its cancellation or amendment, is not held to be an admission that another claim that is narrower than the cancelled claim in some significant respect is necessarily also unpatentable. Patecell v. United States, 12 USPQ2d 1440, 1447 (Cl. Ct. 1989).

4. A Recapture Analysis Should Focus on the Overall Claim Scope and Not on Particular Claim Limitations Not Included in the Reissue Claims

Focusing on the necessity of particular claim limitations to distinguish over the prior art, as opposed to comparing the overall scope of the cancelled claims, or claims prior to amendment, with that of the reissue claims, is exactly the type of analysis dismissed by this Court in Ball Corp. as irrelevant to a recapture analysis:

Similarly, the focus is not, as the Government contends, on the specific limitations or on the elements of the claims, but, rather, on the scope of the claims. . . . The proper focus is on the scope of the claims, not on the individual feature or elements purportedly given up during prosecution of the original application.

Ball Corp., 729 F.2d at 1436-37, 221 USPQ at 295 (emphasis added). Thus, the recapture rule does not, and should not, prevent a patentee from acquiring claims of intermediate scope, i.e., broader than the issued claims, yet narrower than cancelled claims. As succinctly stated by this Court's predecessor:

We therefore find neither decision to be authority for the proposition that a limitation added to a claim in obtaining its allowance cannot be broadened, under present statutory law, by reissue if the limitation turns out to be more restrictive than the prior art required. Certainly one might err without deceptive intention in adding a particular limitation where a less specific limitation regarding the same feature, or an added limitation relative to another element, would have been sufficient to render the claims patentable over the prior art.

In re Richman, 409 F.2d at 275, 161 USPQ at 363. The Richman Court described two permissible ways to broaden claims that contain limitations which were mistakenly added during prosecution and which are narrower than necessary to distinguish over the prior art: (1) the narrow limitation may be broadened so long as the claim scope is still narrower than the original claim prior to cancellation or amendment, or (2) the unnecessarily narrow limitation may be deleted entirely, as long as another limitation is

added to the reissue claim that renders the reissue claim materially narrower, and that defines over the prior art. Id. The latter approach is exactly that used by Clement in submitting reissue claims 49-52 in the present appeal.

B. The Scope of Clement's Application Claims Prior to Amendment is Materially Narrower Than the Scope of Reissue Claim 49 in Several Significant Respects

Under Ball Corp., 729 F.2d at 1435-36, 221 USPQ at 294-95, and the precedent cited above, for Clement to be barred by the recapture rule from obtaining reissue claim 49, the scope of reissue claim 49 must be shown to be of the same or broader scope than a claim that was amended or canceled after being rejected over the prior art. Accordingly, a comparison must be performed between the scope of claim 49 and the scope of a claim the Board asserts Clement is attempting to recapture. Id.

Because the Board did not perform the proper analysis, Clement is left to infer what claim scope the Board asserts Clement was trying to recapture. The only guidance provided by the Board appears at p. 9 of the decision:

It is apparent to us that the Appellant's successful effort to avoid the Ortner-based rejection constitutes an implicit admission that broader claims not restricted to the above-noted room temperature limitation and the combined high temperature/mechanical energy limitations, such as appeal to claims 45-52, were not patentable over the prior art represented by Ortner.

(emphasis added). From this statement, one may conclude that the Board regarded as being impermissibly recaptured a reissue claim having the same or broader scope as any claim presented during the prosecution of the '179 patent that did not include the "room

temperature" or the specific mechanical energy limitations.¹ To perform the analysis mandated by Ball Corp., the scope of any cancelled or amended claim that did not include these particular limitations must be compared to the scope of reissue claim 49 to determine whether Clement is barred by recapture from obtaining reissue claim 49.

1. Original Claim 1 in the Parent Application Prior to the Addition of the Room Temperature and Specific Mechanical Energy Limitations is Materially Narrower than Reissue Claim 49 in Several Significant Respects

In the July 9, 1985, amendment in the parent application, claim 1 was amended to include the room temperature and specific mechanical energy features identified by the Board.² Therefore, to determine whether Clement is guilty of recapture, the scope of claim 1, prior to the July 9, 1985 amendment, must be compared to the scope of reissue claim 49. Ball Corp., 729 F.2d at 1436, 221 USPQ at 295. Claim 1, prior to the July 9, 1985, amendment is set forth below for convenience:

1. (Amended) A method of treating a mixture of printed and contaminated waste paper in order to produce pulps for the use in the manufacture of pulp and paper boards, which method comprises:

- (a) forming an aqueous pulp of said waste material at low temperature, low specific mechanical energy, thereby forming a pulpable slurry and releasing the non-ink contaminants from the surface of the paper but without dispersing them inside the fibrous suspension;

¹ As shown in section I.A.4., supra, recapture analysis that focuses on the necessity of particular claim limitations, as the Board's analysis does, was expressly disapproved of in Ball Corp.

² The Board misread the file history, stating that these limitations were added after claim 1 was cancelled and replaced with new claim 42; see section I.C.3., infra.

- (b) separating the non-ink contaminants from the pulp by mechanical separation, without the use of froth flotation or solvent extraction or other process, using conventional screens and centrifugal cleaners and without any further application of strong shear forces to the pulp;
- (c) softening of the ink particles vehicles and weakening of their bondings with the surface of the fibres by submitting the pulp at a consistency of more than 15% at the simultaneous actions of (A) high temperature - between 85 and 130°C. - (B) high shear forces and (C) at least one de-inking agent, under alkaline conditions;
- (d) detaching the ink particles from the surface of the fibres and dispersing them into the fibrous suspension by submitting the pulp to the simultaneous actions of (A) high temperature -between 85 and 130°C. - (B) high shear forces and (C) at least one chemical dispersing agent, under alkaline conditions;
- (e) removing the free ink particles to provide the degree of brightness required by the final use of the pulp.

(A246-47.) Reissue claim 49 also is set forth below for convenience:

49. A method of treating a mixture of printed and contaminated waste paper in order to produce a pulp for use in the manufacture of paper and paperboards, said waste paper containing non-ink contaminants including stickies which method comprises:

- (a) forming a first aqueous fibrous suspension of said waste paper at a temperature below the melting point of the non-ink contaminants by applying specific mechanical energy sufficient to form a pumpable slurry and to release substantially all of the non-ink contaminants including the stickies from the surface of the paper without dispersing such non-ink contaminants as finely divided particles throughout the fibrous suspension;
- (b) removing substantially all of the non-ink contaminants including the stickies, which have been released without dispersal as finely divided particles from the first fibrous suspension by screening and cleaning to form a second aqueous fibrous suspension substantially free of the non-ink contaminants including the stickies;
- (c) after the step of removing the non-ink contaminants, (1) softening the ink vehicles and weakening their binding with the surface of the fibers, and then (2) detaching the ink particles from the surface of the fibers and dispersing the particles into the second fibrous suspension by submitting the second fibrous suspension at a consistency of more than 15% to the simultaneous actions of temperature, pressure, specific energy and

chemical dosing sufficient to insure softening of the ink vehicles, detachment of the ink particles from the surface of the fibers and dispersion of the detached ink particles into the second fibrous suspension, whereby higher specific energy inputs and higher temperatures are used to detach the ink particles from the fibers of the second fibrous suspension after removal of the non-ink contaminants than are used on the first fibrous suspension before removal of the non-ink contaminants;

- (d) limiting the total duration of step (c) (1) and (c) (2) to a range between 2 and 10 minutes; and
- (e) removing the detached ink particles from the second fibrous suspension to provide a brightness of at least 59 ISO in the final pulp.

(A28-29.) As shown in the columns in the table below, a comparison of these two claims demonstrates beyond dispute that claim 49 is materially narrower than claim 1 in several significant respects, as claim 1 existed prior to the July 9, 1985 amendment.³

<u>Claim 49</u>	<u>Claim 1</u>
1. forming a first aqueous fiber suspension of said waste paper at a temperature <u>below the melting point of the non-ink contaminants</u> forming a first aqueous fibrous	1. forming an aqueous pulp of said waste material at <u>low</u> temperature.
2. forming a first aqueous fiber suspension of said waste paper . . . by applying <u>specific mechanical energy sufficient to form a pumpable slurry</u>	2. forming an aqueous pulp of said waste material at... <u>low</u> specific mechanical energy.

³ The underlined limitations in reissue claim 49 identify limitations not found in claim 1 prior to the July 9th amendment, while the underlined limitations in claim 1 represent those limitations not found in reissue claim 49.

3. to release <u>substantially all of the non-ink contaminants including the stickies</u> from the surface of the paper without dispersing such non-ink contaminants <u>as finally divided particles through the fiber suspension</u> .	3. releasing the non-ink contaminants from the surface of the paper but without dispersing them inside the fiber suspension.
4. removing substantially all of the non-ink contaminants <u>including the stickies</u> , . . . by screening and cleaning	4. separating the non-ink contaminants from the pulp by mechanical separation, <u>without the use of froth flotation or solvent extraction or other process</u> using conventional screens and <u>centrifugal</u> cleaners and <u>without any further application of strong shear forces to the pulp</u>
5. whereby higher specific energy specific energy inputs and higher temperatures are used to detach the ink particles from the fibers of the second fiber suspension after removal of the non-ink contaminants that are used on the first fiber suspension before removal of the non-ink contaminants.	5. forming an aqueous pulp of said waste material at low temperature, low specific mechanical energy . . . detaching the ink vehicles . . . by submitting the pulp to the simultaneous actions of <u>high temperature between 85° and 130°C</u> and high shear forces.
6. chemical dosing sufficient to ensure softening of the ink vehicles	6. at least one de-inking agent, under <u>alkaline conditions</u>
7. <u>limiting the total duration of step C1 and C2 to a range between two and ten minutes</u>	7.
8. removing the detached ink particles from the second fibrous suspension <u>to provide a brightness of at least 59 ISO in the final pulp</u>	8. removing the free ink particles to provide the degree of brightness required by the final use of the pulp

- (a) Reissue Claim 49 is Materially Narrower than Claim 1
Because it Limits the Total Duration of Steps (c)(1) and
(c)(2) to a Range of Between Two and Ten Minutes

Reissue claim 49 includes the limitation that the total duration of steps (c)(1) and (c)(2) is limited to between two and ten minutes. Claim 1 prior to July 9, 1985, contained no such limitation. This limitation is not insignificant or immaterial. For example, in the July 9, 1985 amendment, it was argued that

the process of the invention specifically calls for a total duration of the ink releasing and dispersing treatments between two and ten minutes, as opposed to Ortner's process wherein the same steps are accomplished during the several hours.

(A263.) Thus, the inclusion of this two-to-ten-minute limitation in reissue claim 49 makes that claim materially narrower.

- (b) Reissue Claim 49 is Materially Narrower than Claim 1
Because it Requires a Brightness of At Least 59 ISO

Reissue claim 49 states that the second fibrous suspension of the final pulp has a brightness of at least 59 ISO. Claim 1 in the parent application contains no such limitation. This 59 ISO limitation was considered important by the Examiner in allowing claim 1 in the '179 patent over the prior art. To overcome the Examiner's rejection of the claims based on the Burns article, (A338-39), Clement submitted a declaration of Mr. Burns, the author of the reference. (A417-18.) In the declaration, Burns stated that the method described in his article "is unlikely to achieve a brightness significantly greater than 54 and would not achieve 60 in any feasible manner using group 5 feed stock with comparable quantities of bleach and chemicals." (A418; Burns Decl. at 2.) After this Burns Declaration, the Examiner allowed the claims, but only after Clement agreed in an interview, (A426), to add the 59 ISO brightness limitation by

Examiner's amendment. (A428.) In the Examiner's Statement of Reasons for Allowance, the Examiner explicitly noted that "Burns does not recognize the achievement of the specific brightness now claimed." (A429.) Thus, the 59 ISO limitation is significant and renders reissue claim 49 narrower than claim 1 in this material respect.

- (c) Reissue Claim 49 is Materially Narrower than Claim 1 Because It Recites That Substantially All of the Non-Ink Contaminants Including the Stickies are Removed Prior to Removing the Ink

Reissue claim 49 contains the limitation not found in claim 1 in the parent application that substantially all of the non-ink contaminants including the stickies be removed prior to step (c). Like the 59 ISO brightness limitation, the Examiner allowed the claims in the '179 patent only after this limitation was added, and the Examiner explicitly recognized this limitation as being a reason for allowance: "Burns clearly cleans non-ink contaminants from his stock after the [ink] dispersal unit and flotation as well as before the [ink] dispersal unit whereas applicant cleans only before the disperser, which is claimed in step (b) via cleaning substantially all the nonink contaminants." (A429.) Further, the Burns declaration recognizes that his system could not adequately remove stickies as claimed. (A417; Burns Decl. at 1.) Thus, this stickies removal limitation renders reissue claim 49 narrower in this material respect.

- (d) Reissue Claim 49 is Materially Narrower than Claim 1 Because it Recites That the First Aqueous Fibrous Suspension is Formed at a Temperature Below the Melting Point of the Non-Ink Contaminants

Reissue claim 49 is narrower than claim 1 in the parent application since reissue claim 49 states that the first aqueous fibrous suspension of said waste paper is formed at

a temperature below the melting point of the non-ink contaminants, while claim 1, as shown above, recites only that the temperature of the first aqueous fibrous suspension is "low." During prosecution of the '179 patent, the Examiner contended that the terms "low" and "high" were too vague and were therefore objectionable:

Terms such as "low temperature" and "low specific mechanical energy" "high shear forces" etc. are too relative to be capable of any fixed meaning.

(A255; Rejection dated April 9, 1985 at 3.) This rejection represents an implicit acknowledgment by the Examiner that the terms "low" and "high" are relative terms not capable of a fixed meaning, and therefore are of indeterminate breadth. Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd., 927 F.2d 1200, 1217-18, 18 USPQ2d 1016, 1030-31 (Fed. Cir. 1991), cert. denied, 112 S.Ct. 169 (1991). Accordingly, reissue claim 49, which recites a more specific range having a determinable meaning, is necessarily narrower than a claim which recites the term "low."

(e) The Specific Mechanical Energy Limitation Identified by the Board Is Not Included in Claim 1

The specific mechanical energy limitation identified by the Board is not included in either reissue claim 49 or claim 1 prior to amendment on July 9, 1985. Rather, reissue claim 49 requires that the first aqueous fibrous suspension is formed at a lower mechanical energy than the second aqueous fibrous suspension. Claim 1 uses the relative terms "low" and "high" found to be indefinite by the Examiner. Thus, if anything, the scope of reissue claim 49 is again narrower than that of claim 1 in the parent application with respect to this mechanical energy limitation.

(f) The High Temperature and Other Limitations in Claim 1 and Not Present in Reissue Claim 49 Do Not Alter the Fact that Claim 49 is Materially Narrower than Claim 1 in Several Material Respects

Reissue claim 49 does not include the underscored "high temperature" limitation in element five of the above table and reissue claim 49 does not contain the "without" limitations in element four of the table. The absence of these limitations in claim 49 does not alter the fact that reissue claim 49 is narrower than claim 1 in several material respects as listed above, and that the recapture rule does not apply. In re Richman, 409 F.2d at 276, 161 USPQ at 364 (no recapture where reissue claims are narrower in one significant respect); see also, Ball Corp., 729 F.2d at 1437-38, 221 USPQ at 296 (reissue claims being broader in some respects will not bar reissue claim where "the reissue claims are sufficiently narrower than the cancelled claims to avoid the effect of the recapture rule."). Furthermore, the claim 1 "without" limitations underlined in element four of the table were not required to be included in the allowed claims of the '179 patent. (A23-24.) Therefore, these "without" limitations were not material to patentability and do not render claim 1 broader, in a material way, with respect to claim 49.

2. Reissue Claim 49 Is Materially Narrower than All the Claims in the Parent and Continuation Applications Prior to Amendment or Cancellation

Reissue claim 49 is materially narrower in at least two significant respects than claim 1 in the parent application and claim 42 in the continuation application (as claim 1 was rewritten in the continuation application) at every point during the prosecution of the '179 patent. Claims 1 and 42 prior to cancellation or amendment never included the

59 ISO brightness limitation required by the Examiner to be added to claim 42 before the Examiner would allow the claim. (A426-428.) Additionally, claims 1 and 42 prior to cancellation or amendment never included the limitation that "substantially all of the non-ink contaminants including the stickies," were removed from the first fibrous suspension prior to step (c). Like the 59 ISO limitation, this limitation was required by the Examiner to be added to claim 42 prior to allowance of the claims, (A426-428), and was cited in the Examiner's Statement of Reasons for Allowance. (A429.)

These two limitations, the brightness limitation and the requirement of the removal of substantially all of the non-ink contaminants including the stickies, without question alone materially narrow the scope of reissue claim 49 when compared with the scope of claims 1 and 42 prior to cancellation or amendment during the '179 prosecution. These two limitations were apparently sufficient to render reissue claim 49 allowable over the prior art, since the Examiner has not rejected claim 49 over the prior art. In contrast, claims 1 and 42 were continuously rejected over the prior art until these two limitations were added to the claims. Thus, the recapture rule should not be used to reject any reissue claims otherwise allowable over the prior art, so long as they include the 59 ISO limitation, and the limitation that substantially all of the non-ink contaminants including the stickies are removed prior to step (c), the de-inking stage. In re Richman, 409 F.2d at 275, 161 USPQ at 363 ("Certainly one might err without deceptive intention in adding a particular limitation where . . . an added limitation relative to another element, would have been sufficient to render the claims patentable over the prior art.").

The rejection of claim 49 under 35 U.S.C. § 251 based on the recapture rule is therefore improper and should be reversed. Claims 50-52 depend from claim 49 and

therefore include all the limitations of claim 49. Therefore, these claims are also not barred by the recapture rule, and the rejection of these claims should be reversed as well.

C. Reissue Claims 50-52 Also Are Necessarily Narrower than Claim 1 in the Parent Application

The Board does not individually address claims 50-52, but rather lumps the analysis of these claims in with that of claim 49. Each of claims 50-52 depends from claim 49. (A29.) These claims include all the limitations of claim 49, and are therefore narrower than claim 1 for the same reasons as claim 49 stated above. Furthermore, claim 50 recites that the specific mechanical energy applied in step (a) is lower than 50 KW.H/Ton. Claim 1, prior to the July 9th amendment, did not include this very limitation that the Board stated must be included in the claims. (A9-11.) Accordingly, claim 50 is narrower than claim 1 for this reason as well. Therefore, like claim 49, claims 50-52 are not barred by the recapture rule.

D. The Board's Decision Contains Numerous Errors of Law and Fact That Led the Board to an Incorrect Result Based on the Recapture Rule

1. The Board Impermissibly Focused on Specific Claim Limitations Rather than the Scope of the Claims

In its decision, the Board made no effort to compare the scope of reissue claim 49 to claims in the parent and continuation applications prior to cancellation or amendment, the fundamental inquiry that must be made to determine whether the recapture rule applies. Ball Corp., 729 F.2d at 1436, 221 USPQ at 295. Rather, the Board focused on particular claim limitations added during the prosecution of the parent and continuation applications, and surmised that these exact claim limitations must be

present in any allowable reissue claims because these limitations were believed to be the reason claim 1 of the '179 patent was allowed:

we are convinced that the room temperature limitation in step (a) as well as the combined high temperature/mechanical energy limitations in steps (c) and (d) of the patent claims (i) were deliberately added to overcome the prior art rejections based upon Ortner and Burns respectively, (ii) were argued by the appellant to be features not suggested by Ortner or Burns and (iii) were accepted by the examiner as distinguishing over these references. Since these limitations are not present in appealed claims 49-52, it is evident that these claims are an attempt by the appellant to recapture the broader subject matter which he deliberately surrendered in order to overcome prior art rejections during prosecution of his patent applications.

(A10-11; Board Decision at 10-11.) This statement evidences the Board's misunderstanding of the recapture rule and its application. Assuming arguendo, that everything the Board states is true, the recapture doctrine does not necessarily bar Clement from securing a reissue claim not having these limitations. The recapture rule does not necessarily require that these limitations be present in any allowable reissue claim. Ball Corp., 729 F.2d at 1436-37, 221 USPQ at 294-96; In re Richman, 409 F.2d 269, 274, 161 USPQ at 362 ("The question raised is whether the appealed claims are of the same scope as the cancelled claims, not whether they lack some specific recitation absent from the cancelled claims but included in the patent claims.") (emphasis added).

2. Adding a Limitation to a Claim During Prosecution can be Inferred to be an Admission that the Scope of the Claim Without that Limitation Is Not Patentable, But It Is Not an Admission that Any Claim Not Including that Limitation is Not Patentable

The Board further stated that

It is apparent to us that the Appellant's successful effort to avoid the Ortner-based rejection constitutes an implicit admission that broader claims not restricted to the above-noted room temperature limitation and the combined high temperature/mechanical energy limitations, such as

appeal claims 45-52, were not patentable over the prior art represented by Ortner.

(A9; Board Decision at 9.) (emphasis added). This inference is improper, unfair and legally incorrect. This statement again shows the Board's misunderstanding of the recapture rule. An "admission" under the recapture rule is not that any claims not containing limitations added by amendment, or after cancellation, are not allowable; the admission, if any, is that the particular claim prior to amendment or cancellation with all of its limitations was not allowable over the prior art. In re Petrow, 402 F.2d 485, 488, 159 USPQ 449, 451 (CCPA 1968) ("We do not think there are sufficient facts in the record to base a holding that the cancellation of claim 4 was in any sense an admission that claim 10 was not in fact patentable to appellants at the time claim 4 was canceled."); Patecell v. United States, 12 USPQ2d 1440, 1447 (Cl. Ct. 1989).

3. The Board Misread the Prosecution History

As reflected in the last quoted passage from the Board's decision, the Board supported its recapture analysis based on what it perceived to be a successful effort to avoid the Ortner-based rejection by the addition of the specific temperature and mechanical energy limitations. The Board described where it believed the recapture of subject matter occurred:

First of all, we observe that all of the claims in the Appellant's original patent application Serial No. 06/482,623 were finally rejected under 35 U.S.C. §103 as being unpatentable over Ortner et al. in view of Raymond et al. and Eriksson (see the Office Action mailed August 28, 1985 as Paper No. 8). In response to this Final Rejection, Appellant refiled his application as Serial No. 06/822,943 along with a Preliminary Amendment via which all claims were limited to specific temperature and mechanical energy features (see Preliminary Amendment D filed January 27, 1986 as Paper No. 13).

(A8; Board Decision at 8.) Here, the Board misread the prosecution history. Contrary to the Board's finding, the room temperature limitation, the mechanical energy limitations, and the high temperature limitations all were actually present in claim 1 prior to the preliminary amendment in the continuation application, (A257-260), in which claim 1 was cancelled, and claim 42 was added, (A325-326). Moreover, as stated in the preliminary amendment, claim 42 represents nothing more than claim 1 rewritten to include all of the amendments made to claim 1 during the prosecution of the parent application.⁴ (A326.) The room temperature and specific mechanical energy limitations actually were added in an Amendment in the parent application dated July 9, 1985, (A257-260), in response to the Office Action dated April 9, 1985, in which the claims were rejected as being unpatentable under 35 U.S.C. § 103 over Ortner et al. in view of Raymond et al. and Eriksson, (A254). Claim 1 already contained the high temperature recitation as of April 9, 1985. (A257-260.)

Subsequent to the July 9, 1985 amendment, claim 1 was the subject of the August 28, 1985 final rejection, (A268-71), over Ortner et al. in view of Raymond et al. and Ericksson. The erroneous understanding of the file history by the Board led it to the incorrect conclusion that:

Significantly, the Examiner responded to this claim amendment and argument by dropping the rejection based on Ortner and replacing it with a rejection based on Burns which the Examiner characterized as "clearly closer prior art than the Ortner et al. patent"; see the Office Action mailed September 23, 1986 as Paper No. 14, especially the second full paragraph on page 4.

⁴ Claim 42 does include the limitation "without de-inking agents" that claim 1 never had. This limitation was cancelled from claim 42 prior to allowance, (A378-380), and therefore was not material to patentability.

(A8; Board Decision at 8.) On the contrary, the Examiner's response to the July 9, 1985 amendment to claim 1 was to finally reject the claims as being unpatentable over Ortner in view of Raymond and Eriksson. (A269.)

Thus, the Board's position that Clement successfully avoided the Ortner- based rejection because the foregoing limitations were added to claim 1 was not true, since the Examiner continued to reject claim 1 over Ortner, even after claim 1 was amended to include these features. (A257-260; 268-271.) Furthermore, the only apparent reason the Ortner reference was later dropped was because the Examiner believed Burns to be "clearly closer prior art." (A341.) Even if successfully traversing a rejection is an important consideration in a recapture analysis, the limitations relied upon by the Board did not successfully traverse the Examiner's rejection over the prior art. Only after the addition of the 59 ISO limitation, and the limitation that substantially all of the non-ink contaminants including the stickies are removed prior to step (c), did Clement successfully overcome the prior art.

4. The Fact that the Limitations Identified by the Board had a Role in the Allowance of the Claims is Not Relevant to the Application of the Recapture Rule

Clement agrees with the Board's decision that the claims of the original '179 patent were allowed because of the limitations contained therein. (A9-10; Board Decision at 9-10). This criterion is not, however, the test of whether the recapture doctrine applies. Rather, the scope of cancelled or amended claims prior to amendment must be compared with the scope of the reissue claims being sought. Ball Corp., 729 F.2d at 1436, 221 USPQ at 295.

The Board references the Examiner's reasons for allowance to support its contention of the criticality of the "room temperature" limitation. (A10; Board Decision at 10.) The Examiner stated as reasons for allowance that the claims distinguish over Burns because that reference "does not recognize the removal of stickies prior to the dispersal unit as now claimed with room temperature pulping and cleaning." (A429; Notice of Allowability filed May 16, 1988.) Because of this statement, the Board surmised that:

[t]he fact that the Examiner considered the room temperature limitation of the patent claims to be a reason for allowance controverts the Appellant's position that this limitation played no role in his successful endeavor to distinguish the patent claims over the prior art represented by Burns.

(A10; Board Decision at 10.) Even if the room temperature limitation was a reason for allowance, this fact is not determinative of the application of the recapture rule. While the room temperature limitation may have played a role in distinguishing claim 42 over the prior art represented by Burns, it is not true that amending the claims to add the room temperature limitation was an admission by Clement that reissue claim 49 that includes the limitation that the temperature is "below the melting point of the stickies" is not patentable over the prior art. Therefore, the absence of this "room temperature" limitation does not by itself invoke the recapture rule.

5. The Cases Cited by the Board do not Support Application of the Recapture Rule in this Case

The Board cited three cases to support its application of the recapture rule to Clement. None of these cases provides any support whatsoever for the Board's conclusions. Rather, these opinions clearly support Clement's position. Ball Corp., 729

F.2d at 1437, 221 USPQ at 296, held that the recapture doctrine did not apply as the "reissue claims . . . include[d] limitations not present in the canceled claims." Like Ball Corp., Clement's reissue claims include at least two significant limitations (the 59 ISO brightness limitation, and the limitation of the removal of substantially all of the non-ink contaminants including the stickies) never included in claims 1 or 42 prior to allowance.

Mentor Corp., 998 F.2d at 996, 27 USPQ2d at 1525, also does not support the Board's decision, since recapture was found only where the reissue claims did "not narrow the claims in any material respect" compared to claims cancelled during prosecution. In contrast, Clement's reissue claims have been materially narrowed in scope as compared to claims 1 and 42 prior to allowance.

Lastly, Patecell, 12 USPQ2d at 1447, also fails to support application of the recapture doctrine herein, as the court in Patecell held that, like Clement's claims, the recapture doctrine did not apply where "the reissue claim is narrower than the cancelled claims in a material respect," despite the fact that the reissue claim is broader in other respects.

II. Clement's Reissue Declaration Complies With Both 35 U.S.C. § 251 and 37 C.F.R. 1.175

A. The Reissue Declaration Meets the Statutory Requirements of 35 U.S.C. § 251

Section 251 of the patent statutes provides for reissue of a defective patent:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, . . . by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall . . . reissue the patent

This statute sets forth two requirements that a reissue declaration must satisfy: (1) the

declaration must state that the patent is defective, for example, because the patentee has claimed more or less than he is entitled to; and (2) the applicant must allege that the defective patent arose through error without deceptive intent. Hewlett-Packard, 882 F.2d at 1564, 11 USPQ2d at 1757.

In Clement's reissue declaration filed April 24, 1993, (A36-43), Clement declared that he believed that the '179 patent was "wholly or partially invalid or inoperative by reason of my claiming more or less than I had a right to claim." (A37.) Mr. Clement further declared that the errors "arose without any deceptive intention on my part." (A42.)

These statements clearly satisfy the statutory requirements for the reissue declaration. Indeed, the Board does not contest that the declaration meets these requirements, but apparently believed that because it found the declaration defective under 37 C.F.R. § 1.175, the declaration also did not comply with the statute:

For these reasons, we agree with the examiner that the appellant's reissue declaration is defective under 37 C.F.R. § 1.175. . . . It follows that we will sustain the § 251 rejection of claims 1-18 and 49-52 as being based on a defective reissue declaration.

(A6-7; Board Decision at 6-7.) Since the only basis for finding the reissue declaration defective is non-conformance with 37 C.F.R. § 1.175, and since the declaration has been shown to meet the two statutory requirements above, the Board erred in rejecting the claims under 35 U.S.C. § 251 as being based on a defective reissue declaration. See Hewlett-Packard, 882 F.2d at 1564, 11 USPQ2d at 1757.

B. Clement's Reissue Declaration Also Meets the Requirements of 37 C.F.R. § 1.175

37 C.F.R. § 1.175(a)(5) requires that the reissue declaration contain a statement

"[p]articularly specifying the errors relied upon, and how they arose or occurred." In conformance with the rule, the errors were particularly specified by Clement in his declaration:

As a result of these discussions, my U.S. attorneys determined that original claims 1-18 of U.S. Patent No. 4,780,179 were unduly limited in view of the teachings of the disclosure and the prior art. In particular, claim 1, step (a) recites forming the first fibrous suspension at room temperature by applying specific mechanical energy lower than 50 KW. H/Ton. These limitations are, however, inconsistent with the invention in its broadest terms. . . .

Claims 1-18 are also unduly limited with respect to the temperature, mechanical energy and pH conditions set forth in steps (c) and (d) of claim 1. . . .

(A39; Clement Decl. at 4.) The declaration further described how these errors arose:

The above-stated errors relied upon as the basis for this reissue application occurred prior to 1987 during the early prosecution of the '943 application, which matured into original United States Letters Patent No. 4,780,179 I did not then appreciate, and my U.S. attorneys did not explain to me, that the process conditions under which the first fibrous suspension is formed and the softening, detaching and dispersing steps are carried out could be made more definite without reciting the specific parameters contained in original claim 1.

The lack of appreciation on my part was due to my very limited understanding of U.S. patent law and the difficulties I had in explaining the invention to my U.S. attorneys through written communications requiring translation from Italian to English or vice versa by my Italian attorney. My U.S. attorneys failed to advise me as to the proper claim scope to which I was entitled because they simply did not understand all of the technical aspects of the invention. The above errors were confirmed only after I had an opportunity to thoroughly discuss the invention face to face with my U.S. attorneys on April 22, 1993. For example, it was only during those discussions that my attorneys realized for the first time that the mechanical energy applied during the formation of the first fibrous suspension and the softening, detaching and dispersal steps also adds heat to the system. Therefore, this factor must always be taken into account when deciding on the overall conditions under which these steps are carried out. Further, my attorneys failed to realize until this time that many different types of ink are present in the various waste papers treated and that those skilled in the art recognize that these inks require varying process conditions for

softening, detachment and dispersion.

(A41-42; Clement Decl. at 6-7)

Without question, the facts set forth above regarding communication difficulties with counsel, and a failure of counsel and Clement to appreciate that the claimed invention need not include these specific limitations, meet the requirement of particularly specifying the errors and how they arose without deceptive intention. Mentor Corp., 998 F.2d at 995, 27 USPQ2d at 1524 (An attorney's failure to appreciate the full scope of the invention is not an uncommon defect in claiming an invention.); Ball Corp., 729 F.2d at 1433, 221 USPQ at 292 (error based on "inadequate and/or ineffective communication" with patent attorney); In re Wesseler, 367 F.2d at 842, 151 USPQ at 342 (error based on patentee's lack of familiarity with patent matters and inability to evaluate whether the claims afforded adequate protection). Since Clement's reissue declaration satisfies the requirement of 37 C.F.R. § 1.175, the rejection of the claims thereunder as being based on a defective declaration should be reversed.

C. There Is No Support for the Board's Position That the Specific Errors Did Not Arise Due to Communication Difficulties with Clement's U.S. Attorneys

The Board correctly stated that the limitation relating to temperature in steps (c) and (d) of claims 1 and 42 was present in the original claims of the parent application and continued to be present throughout prosecution of the '179 patent. From this fact, the Board inexplicably concluded that:

[i]t is apparent, therefore, that the temperature limitation in steps (c) and (d) of patent claim 1 did not occur due to communication difficulties with the U.S. attorneys during prosecution of the patent applications as stated in the reissue declaration.

(A6; Board Decision at 6.) It is not understood why the communication difficulties referred to in Clement's declaration could not have resulted in the high temperature limitation being included in the originally filed claims. Certainly the Board cited no support for its refusal to accept the sworn statement of Clement, and there is no basis in the record for not believing Clement. Clement's statement in his declaration that the "errors relied upon as the basis for this reissue application occurred prior to 1987 during the early prosecution of the '943 application," certainly would include errors incorporated into the claims when the application was first filed. This parent application was based on an earlier filed Italian application, and translations of the application and preparation of the claims in English were required. This entire process required overseas instruction from and consultation with Clement in a language foreign to Clement. This process was part of the early prosecution of the parent application and had a strong potential for miscommunication due to the language difference.

D. The Room Temperature Limitation Was Specifically Referred to in the Declaration

The Board stated that "the reissue declaration does not specify the room temperature limitation in step (b) of patent claim 1 as an error (or explain how it arose) even though step (b) of newly added claim 49 defines the corresponding temperature limitation in broader terms."

The "room temperature" limitation is specifically referenced in the first paragraph of Clement's declaration reproduced above. The paragraphs that follow in the declaration give a detailed account of how the error arose relating to this unduly narrow limitation. Therefore, the Board's statement that the declaration does not specify the room temperature limitation is simply not true.

E. Non-Conformance with 37 C.F.R. § 1.175(a)(5) is Correctable While the Application is Still Pending

Since the Board has no basis for finding the Clement declaration defective under 35 U.S.C. § 251, at most, the Board has alleged lack of particularity that might render the declaration defective under 37 C.F.R. § 1.175(a)(5), as failing to adequately specify the errors and how they arose. This type of lack of particularity can be cured by revising the declaration. Revising a reissue declaration by submitting a supplemental declaration to conform to 37 C.F.R. § 1.175 is a common practice during pendency of a reissue application. See Manual of Patent Examining Procedure, § 1444. The only requirement that must be met is that the reissue application not be passed to issue "without full compliance with 37 C.F.R. 1.175." Id. Accordingly, despite Clement's arguments to the contrary, even if the Court agrees that the Clement declaration does not adequately specify the errors or how they arose, should the Court find for Clement on the recapture issue, a remand to the Examiner would be appropriate. In this manner, Clement would be given a chance to conform his declaration to the rule, as the Board decision, as shown above, is entirely unclear as to exactly why Clement's declaration is defective.⁵ Moreover, no rule or statute prevents Clement from simply filing a continuation of this

⁵ A remand would be particularly just, as the Patent Office has now recognized that "the current requirement in Sec. 1.175(a)(5) that it be shown how the error(s) being relied upon arose or occurred without deceptive intent on the part of the applicant appears to be unduly burdensome upon applicant and the Office, and is proposed to be deleted." 61 Fed. Reg. 49836 (1996) (proposed September 23, 1996).

application, and submitting a proper, conforming declaration.

III. The Rejections of Claims 1-18 Are Improper and Should Be Withdrawn

Without discussion, the Board included claims 1-18 in the rejections based on an inadequate declaration and the recapture rule. (A3; Board Decision at 3.) Claims 1-18 are identical to claims 1-18 in the original '179 patent, and were simply carried over into the Clement reissue application. This rejection was improper. In Hewlett-Packard Co., 882 F.2d at 1567, 11 USPQ2d at 1759, this Court held that a rejection of new reissue claims because of a lack of error warranting reissue only invalidated the new reissue claims, and not the original claims carried over into the reissue application. Accordingly, the rejection of claims 1-18 under 35 U.S.C. § 251 and 37 C.F.R. § 1.175 should be reversed.

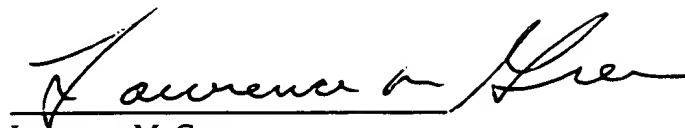
CONCLUSION

For the foregoing reasons, the decision of the Board should be reversed and claims 1-18 and 49-52 should be allowed.

Respectfully submitted,

JEAN MARIE CLEMENT

March 21, 1997

A handwritten signature in cursive script, appearing to read "Lawrence M. Green", written over a horizontal line.

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CERTIFICATE OF SERVICE

I, Christopher S. Schultz, attorney for Jean-Marie Clement, certify that on March 21, 1997, I served two copies of the affixed Appeal Brief by overnight mail to the Office of the Solicitor, Crystal Park, Bldg. No 2, 2121 Crystal Drive, 9th Floor, Rm 918, Arlington, Virginia 22215.

Date: March 21, 1997

Christopher S. Schultz